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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,399	01/23/2002	John J. Gregel	ERICP0329USA	7238
7590	03/24/2005		EXAMINER	
Jonathan A. Platt Renner, Otto, Boisselle & Sklar, LLP Nineteenth Floor 1621 Euclid Avenue Cleveland, OH 44115-2191			OMGBA, ESSAMA	
			ART UNIT	PAPER NUMBER
			3726	
DATE MAILED: 03/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/055,399	Applicant(s) GREGEL ET AL. 	
	Examiner Essama Omgba	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-12, 14-21 and 35-62 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 4-12, 14-21, 42-48, 61 and 62 is/are allowed.
6) ☐ Claim(s) 35, 37-39 and 49 is/are rejected.
7) ☐ Claim(s) 40, 41 and 50-60 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 6 and 15 are generic and allowable. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claims 10-12, 18 and 20, directed to the species of figures 4 and 5, are no longer withdrawn from consideration since all of the claims to this species depend from or otherwise include each of the limitations of an allowed generic claim.

In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 35, 37-39 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werner (US Patent 4,408,926).

With regards to claims 35 and 49, Werner discloses a rebar tool comprising pivoting arms 76, a distal end of each pivoting arm being provided with a notch 84 to accommodate a bar passing therethrough, each distal end also including a bearing section on each side of the notch with a rounded surface (figure 6), see column 3, lines 18-26. Although the arms of the tool of Werner are not power operated such as by a piston-cylinder assembly, however it is within the general knowledge of one of ordinary

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skill in the art to convert such arms to power operated arms. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have converted the arms of Werner's tool to be power operated by a piston-cylinder assembly as is within the general knowledge of one of ordinary skill in the art. Note that Werner discloses that a hydraulic tool could be used for driving the collars (col. 3, lines 36-37).

For claims 37-39, Applicant should note that the arms of the tool of Werner could drive shear tooling, bar forming tooling and coupling forming wedge sleeve driving tooling.

Allowable Subject Matter

4. Claims 4-12, 14-21, 42-48, 61 and 62 are allowed.
5. Claims 40, 41 and 50-60 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments filed January 3, 2005 have been fully considered but they are not persuasive.

In response to Applicant's arguments that Werner does not disclose how the handles 76 accomplish the described movement of the driving heads 78, Applicant should note that the features upon which Applicant relies (i.e., how the handles

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accomplish the movement of the driving heads) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore the claims are drawn to an apparatus and not to a method of using the apparatus. The examiner has outlined in the above rejections how the structure of Werner matches Applicant's claimed structure and Werner's apparatus is capable of forming a bar connection as claimed by Applicant.

In response to Applicant's argument that Werner's tool does not disclose a rounded surface for engaging rebar tooling, Applicant should note that the broadly recited rounded surfaces on each side of the notch are met by the outside surface of inserts 82. Furthermore a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In the instant case Werner's tool is capable of driving sleeves 66 over jaw assembly 46.

In response to Applicant's argument that Werner's tool is not operative, the examiner has no reason for disregarding Werner's teachings that tool 74 may be used to drive collars 66 onto jaw assemblies 46, the tool including conventional handles 76,

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which when moved towards each other, move the two driving heads 78 towards each other in a conventional manner (col. 3, lines 18-22).

Regarding the recitation of a piston-cylinder assembly to drive the seats axially, it is within the general knowledge of one of ordinary skill in the art to substitute power operated arms to hand manipulated ones since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. In re Venner, 120 USPQ 192.

Furthermore as shown above Werner teaches that a hydraulic tool could used for driving the collars.

In view of the above remarks, the examiner maintains that a prima facie case of obviousness has been established in the instant application.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (571) 272-4532. The examiner can normally be reached on M-F (10-7:30) First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Essama Omgba
Primary Examiner
Art Unit 3726

eo
March 18, 2005